

REMARKS

Claims 1-24 are pending, of which claims 1, 15, and 19 are in independent form.

Claims 1, 8-16, 19, and 22-24 have been amended by way of the present Response. No new matter is introduced. Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Drawing Objections

Responsive to the comments in the pending Office Action, Applicant has appropriately amended block 510 of FIG. 5A so as to rectify a spelling error in the term "service" therein.

Regarding the Claim Rejections - 35 U.S.C. §112

In the pending Office Action, claims 2, 17, and 20 are rejected under 35 U.S.C. §112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The following comments were provided with respect to these §112 rejections:

Claim 2 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Applicant respectfully traverses the pending §112 rejections as set forth above and submits that claims 2, 17, and 20 are in proper Markush form wherein the phrase "the group" is recited without a prior recitation of the term "group" in the claims. An example of a proper Markush group recitation is provided in MPEP 2173.05(h) where it states: "selected from the group consisting of amino, halogen, nitro, chloro and alkyl". Another example is also provided in MPEP 2173.05(h) where it states: "wherein R is a material selected from the group consisting of A, B, C and D". It is accordingly believed that Applicant's recitation of the Markush group "wherein said at least one imaging appliance is selected from the group consisting of a digital camera, a scanner, a hand-held Optical Character Recognition (OCR) reader, a camcorder, and a device using a predetermined portion of the electro-magnetic spectrum for image capture" in claims 2, 17, and 20 is consistent with the accepted form of the Markush claim format.

Regarding the Claim Rejections - 35 U.S.C. §102

In the pending Office Action, claims 1, 2, 8, and 12 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,324,545 to Morag (hereinafter the *Morag* reference). Also, claims 19-24 are rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,003,065 to Yan et al. (hereinafter the *Yan* reference).

Applicant respectfully submits that these §102 rejections have been overcome or otherwise rendered moot by the present amendment. As currently constituted, the base claims 1 and 19 recite the limitation, *inter alia*, of determining whether at least one imaging appliance comprises image processing capability sufficient to process a captured image.

The *Morag* reference appears to disclose a method of generating a photo album wherein a set of digital images may be sent by a customer over the Internet to a service provider for processing the images into an album. See FIG. 1; see also col. 6, lines 5-10. The *Yan* reference appears to be directed to a distributed data processing system having a host computer coupled by way of a network to one or more peripheral devices, where processing of applications can be expedited because executables running on the host device can also be downloaded and executed on a target

peripheral device. Col. 5, lines 17-26. It is respectfully contended that the applied references do not teach or even allude to the current limitations of the base claims 1 and 19 as set forth above.

Dependent claims 2, 8 and 12 depend from the base claim 1 and introduce additional limitations therein. Likewise, dependent claims 20-24 depend from the base claim 19 and introduce additional limitations therein. Accordingly, these dependent claims are also not anticipated by the *Morag* and *Yan* references as applied to the base claims 1 and 19, respectively.

Regarding the Claim Rejections - 35 U.S.C. §103(a)

In the pending Office Action, claims 3 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over the *Morag* reference in view of U.S. Patent No. 5,699,460 to Kopet et al. (hereinafter the *Kopet* reference). Additionally, claims 5-8, 9-11, and 13-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over the *Morag* reference in view of the *Yan* reference. Finally, claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over the *Morag* and *Kopet* references as applied to claim 3 above, and in further view of the *Yan* reference.

Applicant respectfully submits that these various §103(a) rejections have been overcome or otherwise rendered moot by the present amendment. With respect to the *Morag* and *Kopet* references as applied against claims 3 and 4, Applicant points out that the *Morag* reference is insufficient, as explained above, when applied against the base claim 1 from which claims 3 and 4 depend. Application of the *Kopet* reference, however, is of no avail in curing this insufficiency of the primary reference, i.e., the *Morag* reference, when combined as a basis for obviousness. It is well known that to establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the combined references must teach or suggest all the claim limitations. See MPEP §2143. Applicant respectfully contends that there is no suggestion or motivation in either of the applied references to combine the teachings therein so as to achieve the claimed invention directed to a device-initiated image processing transaction method that comprises, *inter alia*: determining whether at least one imaging appliance comprises image processing capability sufficient to process a captured image. As set forth above, the *Morag* reference appears concerned with generating a

personalized photo album of digital images by a service provider. On the other hand, the *Kopet* reference appears directed to an image compression/decompression coprocessor integrated on a single chip. Col. 3, lines 18-24. Applicant respectfully submits that there is no suggestion or motivation as to combining the teachings of the applied references or modifying the references because providing a single-chip image coprocessor is unrelated to the claimed device-initiated image processing transaction method that involves interaction between an imaging appliance and an image processing service provider, upon determination that the imaging appliance comprises image processing capability sufficient to process a captured image. Additionally, even if the teachings of the applied references were to be combined, the combined references fail to teach or suggest all the limitations of the claimed device-initiated image processing transaction method as currently constituted. Accordingly, claims 3 and 4 depending from the base claim 1 are allowable over the *Morag* and *Kopet* references.

With respect to the *Morag* and *Yan* references as applied against claims 5-8, 9-11, and 13-17, Applicant respectfully submits again that these claim rejections have been overcome or otherwise rendered moot by the present amendment in view of the foregoing discussion. Claims 5-8, 9-11, 13, and 14 depend from the

base claim 1, and as explained above, the *Morag* reference does not suggest or even remotely allude to the limitations of the base claim 1 as currently constituted. The *Yan* reference, which appears to be directed to a distributed data processing system, does not cure the deficiencies of the *Morag* reference. Because similar claim limitations have been incorporated in the currently-amended base claim 15, the combination of *Morag* and *Yan* references is of no avail as applied against this base claim and the dependent claims 16 and 17 as well. Additionally, combining the *Kopet* reference with these two references as applied against claim 18 that depends from the base claim 15 is also of no avail for the same reasons.

Accordingly, Applicant respectfully submits that claims 5-8, 9-11, 11-17, and 18 are allowable over the entire art of record.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present invention, as now defined by the independent claims, and in further view of the above amendments and remarks, reconsideration of the Action and allowance of the present invention are respectfully requested and are believed to be appropriate.

Respectfully submitted,

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Attachments: Replacement Sheet (5/6)
Annotated Sheet (5/6) Showing Changes

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings (sheet no. 5/6) includes changes to FIG. 5A. This drawing sheet, which includes FIG. 5A only, is in compliance with 37 C.F.R. §1.121(d) and replaces the original sheet (5/6). Block 510 of FIG. 5A has been amended so as to rectify a spelling error in the term "service" therein.

Attachments: Replacement Sheet

Annotated Sheet Showing Changes



5/6

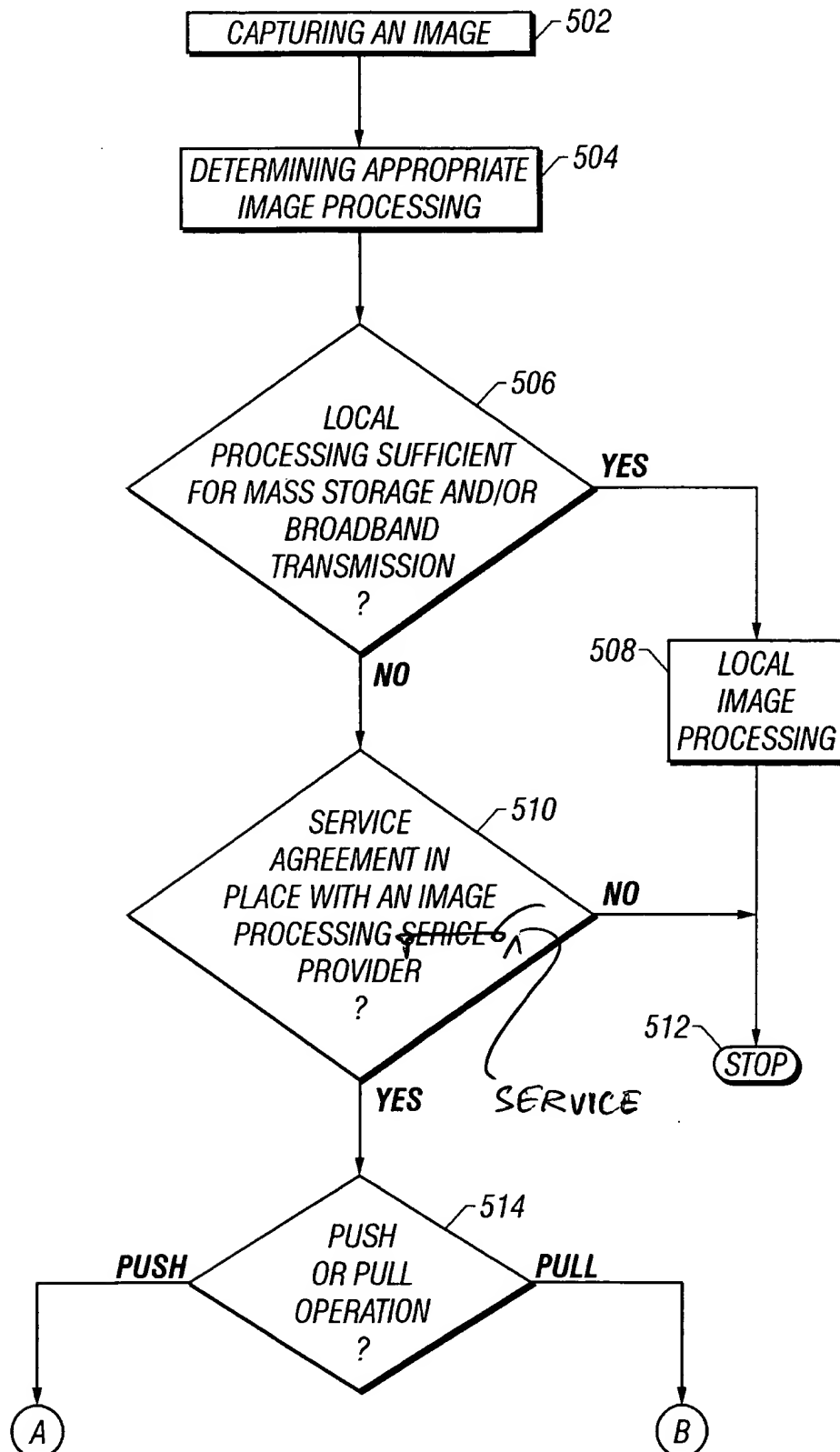


FIG. 5A